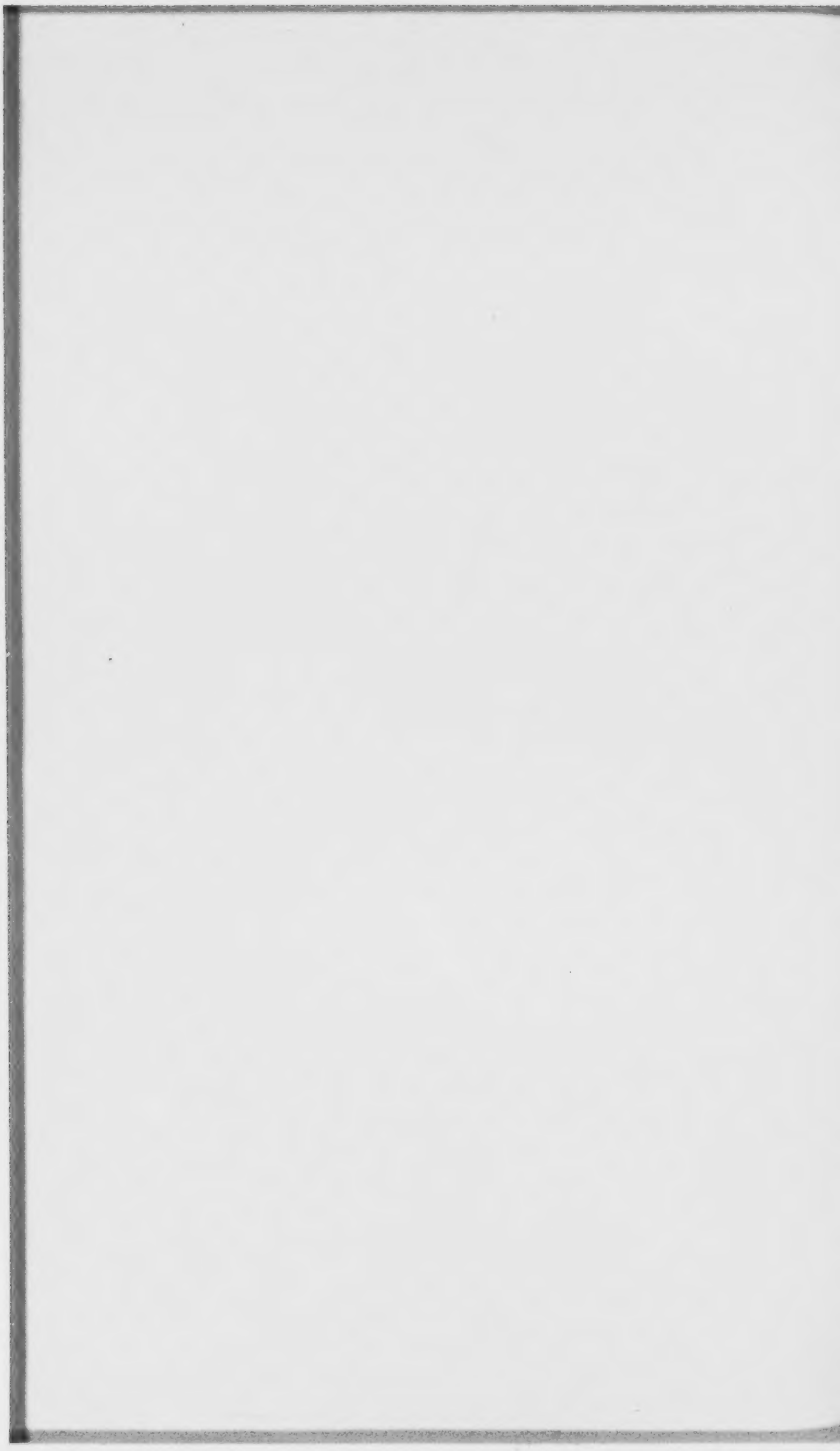

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1942

No. 509

GEORGE VAN WORMER,

Petitioner,

v.

THE CHAMPION PAPER & FIBRE COMPANY,

Respondent.

PETITION FOR REHEARING OF PETITION FOR WRIT OF CERTIORARI

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THE JOHNSON & HARDIN CO., LAW PRINTERS
CINCINNATI, OHIO

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To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner respectfully requests a reconsideration of its Petition for Writ of Certiorari that was denied upon December 7, 1942. Your petitioner's case is quite distinct from the case of *Hailes* v. *Albany Stove Co.*, 123 U. S. 582, 587, to which prominence is given in *Milcor Steel Co.* v. *George A. Fuller Co., et al.*, 316 U. S. 142, 147, 148. In

Hailes v. *Albany Stove Company,* the disclaimer was as follows:

> "Your petitioners, therefore, hereby enter their disclaimer to so much of the first claim as covers perforations or openings in the sides of a suspended firepot extending throughout the entire depth of sides, and limiting such perforations or openings to substantially the lower half of the firepot, the material or substantial part of the thing patented in and by said claim not hereby disclaimed being as follows:
>
> > 'A firepot suspended from its upper edge with substantially the upper part of its sides made solid, and substantially the lower half of its sides containing perforations or openings.' "

Of this the Court said:

> "This is what has been attempted in this case. There is no word, or hint, in the patent, that the invention claimed was a firepot with sides grated only half-way, or part of the way from the bottom towards the top, or that partially grated sides have any advantage over those grated all the way to the top. The first claim, as modified by the disclaimer, has nothing in the specification to stand upon, nothing to explain it, nothing to furnish a reason for it."

The facts in this case are quite distinct from the facts in your petitioner's case. This is shown by what the Court of Appeals said about your petitioner's specification, viz:

> "Moreover, we think that appellee's contention that the disclaimer introduced a new element into the claim and hence invalidates it must be sustained. The limitation in the disclaimer to the use of a brush composed of hog bristles does not extend the claim. It originally specified paper brushing devices, and such devices might be either of camel's hair or bristles, or of any proper brush material. However, the claim as originally written does not include the rotation of the brushes. It is quite conceivable that under the broad

> phrase 'paper brushing devices therein arranged' the brushes might be vibrated instead of rotated. Appellee urges, and it is true, that the specifications described rotation of the brushes, but that does not save the claim which is so broadly drawn as not to include this element." 129 Fed. Rep. 2(d), 428-430.

Your petitioner's case therefore is distinct from *Hailes* v. *Albany Stove Co.*, in that the limitation placed on the claim by the disclaimer was described in your petitioner's specification, and was not described in the specification in *Hailes* v. *Albany Stove Company.*

In *Milcor Steel* v. *George A. Fuller Co.*, supra, after referring to *Hailes* v. *Albany Stove Co.*, this Court says:

> "If an alteration of one of the essential elements of a claimed combination were permissible at all it would be under the reissue statute, Rev. Stat. § 4916, 35 U. S. C. § 64, which grants rights only from the date of reissue and after consideration of the patent office."

However, it is submitted that your petitioner's patent was subject to the right of disclaimer because the part which the patentee disclaimed, viz: brushing devices other than the brushes rotating in the direction of the paper, was distinguishable on the face of the specification. The correction therefore was one that need not be made by reissue. *Grasselli Chemical Company* v. *National Aniline & Chemical Co.*, 26 Fed. (2d) 305-310 (C. C. A. 2nd).

Your petitioner's case is further distinct from *Milcor Steel* v. *George A. Fuller Co.*, in which this Court said:

> "Limiting ourselves as we must to the original claims to determine the nature of the combination covered by the patent when it was granted, and comparing that combination with the one purportedly embodied by the claims after the disclaimer, we can only conclude that the revised patent *includes new elements* which were not present in the original." (Italics ours.)

The Court then in *Milcor* v. *Fuller,* supra, analyzes *Altoona* v. *Tri-Ergon Corp.,* 294 U. S. 477, and says that the Court: "concluded that the disclaimer statute 'does not permit the *addition of a new element* to the combination previously claimed whereby the patent originally for one combination is transformed into a new and different one for the new combination.' "

In both *Milcor* v. *Fuller* and *Altoona* v. *Tri-Ergon Corp.,* supra, this Court held the disclaimers invalid on the ground that they added new elements which were not present in the combination originally claimed. However, in both of these cases the original claims did include "the element" in broad terms, and the disclaimers purported to include this "element" in a specific form, namely, a "fly-wheel" in one of the cases and an "angle iron" in the other case. In your petitioner's case the Court referred to something intangible, viz: *rotation* of the brushes as an "*element*" not present in the original claim.

It is submitted that the characterization of the change of an element of a combination from general terms to specific terms as an addition of an element has no precedent in the Patent Law, and that this has led the Court in the instant case to characterize *rotation* of brushes as an element. See *Pickering* v. *McCullough,* 104 U. S. 310-318, for definition of "an element" of a combination. It is submitted that this shows that there is need for clarification of what is meant by the addition of an element to a combination as used in *Altoona Publix Theatres* v. *American Tri-Ergon,* and *Milcor Steel* v. *George A. Fuller,* supra.

Respectfully submitted,

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Counsel for Petitioner.